

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 10/582,602

Confirmation No. 2195

Applicant: Akahoshi et al.

Filed: June 30, 2006

TC/AU: 1624

Examiner: Jarrell, Noble E.

Docket No.: 701019 (Client Reference No. 201493)

Customer No.: 23460

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO OFFICE ACTION

Sir:

In reply to the Office Action dated February 26, 2008, please consider the following remarks.

Remarks/Arguments begin on page 2 of this paper.

*REMARKS/ARGUMENTS**The Restriction Requirement*

The Office sets forth a restriction requirement between the following three groups of claims:

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|-----------|--|
| Group I | claims 1-4, 7, and 12-16 (directed to a compound of formula (I), in which $m+n$ is 2, p is 0, Y is S, and X is CHR^3), |
| Group II | claims 1-4, 7, and 12-16 (directed to a compound of formula (I), in which $m+n$ is 2, p is 1, Y is S, and X is CHR^3), and |
| Group III | claims 1-7 and 11-16 (directed to compounds of formula (I) or (III) not encompassed by Group I or II). |

The Office further requires Applicants to indicate a species selection for the elected group.

Applicants' Election

Applicants elect, with traverse, the claims of Group I (claims 1-4, 7, and 12-16) for examination. In response to the Office's request, Applicants also elect, with traverse, the compound of Example 2, *i.e.*, 3-((S)-2-amino-2-{*cis*-4-[4-(5-cyano-2-pyridyl)-1-piperazinyl]-1-cyclohexyl}acetyl)-1,3-thiazolidine. Following the structure of formula (I) laid out in claim 1, the elected species has the following substituents:

- R^1 , R^2 , and Z are hydrogen;
- X is $-\text{CHR}^3$;
- Y is S;
- p is 0;
- m is 2; n is 0; $m+n = 2$;
- R^3 is a compound of formula (II), in which
 - --- represents a single bond;
 - R^{22} is a substituted heteroaryl;
 - q is 1; and
 - A is N.

Claims 1-4, 7, and 13-16 read on the elected species.

Reconsideration of the restriction requirement, at least in part, is hereby requested.

Discussion of the Restriction Requirement

The subject application is a U.S. national stage application based on the international application PCT/JP04/18479. The Office alleges that the inventions defined by the claims of Groups I-III do not relate to a single general inventive concept under PCT Rule 13.2 because they lack the same “special technical feature.” Under PCT Rule 13.2, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. PCT Rule 13.2 defines the term “special technical feature” as meaning the technical feature that defines the contribution which each claimed invention, considered as a whole, makes over the prior art (see M.P.E.P. § 1893.03(d)).

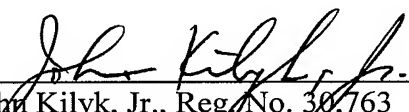
The claims of Groups I and II are linked so as to form a single general inventive concept. In other words, the claims of Groups I and II share at least one common special technical feature, which defines the contribution that each claim makes over the prior art. In this respect, the claims of Groups I and II all recite the special technical feature of a common core structure, in which $m+n$ is 2, Y is S, and X is CHR³. The only structural difference between the compounds of Group I and Group II is whether p is 0 (Group I) or p is 1 (Group II).

Moreover, in view of the significant core structure common to the compounds of Groups I and II, any search and consideration of the claimed subject matter of Group I will likely overlap the search and consideration of the claimed subject matter of Group II. More specifically, a search for prior art with respect to Group I would likely uncover references that would be considered by the Examiner during the examination of Group II, and *vice versa*. As a result, it is submitted that the Examiner would incur no undue burden in examining the claims of Groups I and II at the same time. See M.P.E.P. § 803 (“If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” (emphasis added)).

In view of the foregoing, Applicants request that the requirement for restriction be withdrawn in part so that the claims of Groups I and II are examined together.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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